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09/131,915 08/10/98 ARBOGAST

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022850 QM12/0330
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EXAMINER

PREPUBLICATION

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/131,915

Applicant(s)

Argoblast et al

Examiner

Paul Prebilic

Group Art Unit

3738



☒ Responsive to communication(s) filed on Feb 25, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 22-51 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 22-51 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Drawings

The drawings are objected to because each view needs to be separately labeled as "1a, 1b, 2a, 2b, etc. and the "Brief Description of the Drawings" need to at least mention each figure.

Correction is required.

The abstract of the disclosure is objected to because it is too concise and does not give enough detail of the invention. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 24 and 46-51 are objected to because of the following informalities:

With regard to claim 24, the meaning of the terminology "and/or" is not understood. It will be interpreted as meaning "or".

With regard to claims 46-51, it is unclear which element(s) previously recited contains the recited feature.

With regard to claims 46 and 47, "comprising" should be ---further comprising--- so that it is clear that an additional features are being claimed. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 22-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,830,237. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are narrower in scope but are so similar to the patented claims that the patented claims read on the present claims. For this reason, the claims are considered to be obvious in view of each other.

Claims 22-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5,603,122. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are narrower in scope compared to the patented claims but are similar enough to be read on the patented claims. For this reason, the patented claims are considered obvious in view of the present claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 22-43 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kania (US 5,830,237); see the entire document, especially Col. 5, lines 1-44.

Claims 22-29 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kania (US 5,603,122); see the entire document.

Claims 22, 24, 26, 28, 29, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Caspers (US 5,258,037) wherein the gel is met by the viscoelastic polymer of Caspers and the Examiner asserts that the Shore hardness limitations is met because the Caspers device inherently has some Shore hardness; Applicant is burdened to show otherwise by testing the Shore hardness of Caspers. In addition, it is noted that mineral oil is only an optional ingredient according to the present claims; see Col. 8, lines 2-15 and Col. 9, lines 33-43.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kania (5,830,237) in view of Laghi (US 5,443,525). Kania meets the claim language except for the use

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of transducers as claimed. Laghi, however, teaches that it was known to the art to use transducers in order to detect the condition of the prosthetic device and the patient wearing the device; see the entire document. Hence, it is the Examiner's position that it would have been obvious to use transducers with the Kania device for the same reasons that Laghi uses the same.

Claims 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kania (US 5,830,237) in view of Lohmann (US 5,728,167). Kania meets the claim language but fails to disclose the use of orthotic equipment such as support bars and orthotic joints. Lohmann, however, teaches that it was known to use orthotic devices with similar prosthetic liner devices. Hence, it is the Examiner's position that it would have been obvious to use similar orthotic equipment with the Kania device in order to make it adaptable to many patients' needs.

Claims 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kania (US 5,830,237) and Lohmann (US 5,728,167) as applied to claims 44-47 above, and further in view of Laghi (US 5,443,524). Kania lacks the use of transducers as claimed. Laghi, however, teaches that it was known to the art to use transducers in order to detect the condition of the prosthetic device and the patient wearing the device; see the entire document. Hence, it is the Examiner's position that it would have been obvious to use transducers with the Kania device for the same reasons that Laghi uses the same.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Lerman teaches the concept of lateral to longitudinal stretches comparisons; see Col. 5, lines 27-42.


The Silipos brochure shows that fabric covered gel prostheses of silicone were known

The Norman (GB) patent teaches the that membranes of only a portion of the inner layer were known.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (703) 308-2672. The fax phone number for this Technology Center is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.


Paul Prebilic
Primary Examiner
Art Unit 3738